

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Art Unit: 2131
Geoffrey B. Rhoads Conf. No.: 1809
Application No.: 10/658,808
Filed: September 8, 2003 **Via Electronic Filing**
For: Method for Increasing the Functionality of
a Media Player/Recorder Device or an
Application Program

Examiner: S. Chen

Date: June 22, 2010

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
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Sir:

Appellants respectfully request the Board of Patent Appeals and Interferences (hereafter the “Board”) to *reverse* the outstanding final rejection of the pending claims.

This Appeal Brief is in furtherance of a Notice of Appeal filed December 22, 2009.

Please charge the fee required under 37 CFR 1.17(f) or any other fee needed to consider this Appeal Brief to our deposit account no. 50-1071.

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REAL PARTY IN INTEREST

The real party in interest is Digimarc Corporation headquartered in Beaverton, Oregon.

RELATED APPEALS AND INTERFERENCES

An Appeal Brief was filed on May 28, 2008 in assignee's U.S. Patent Application No. 11/382,855. On December 24, 2009, the Board issued a BPAI Decision – Examiner Reversed (reversing the rejection, introducing a new rejection, and asking for examination of dependent claims) in the '855 application. The '855 application and the present application both claim priority to provisional application no. 60/134,782.

STATUS OF CLAIMS

Claims 1-40, 42, 43 and 46-59 are pending in the present application. *See the September 1, 2009 final Office Action, Office Action Summary, item 4.*

Each of the pending claims stands finally rejected and is on appeal.

Claims 41, 44 and 45 were previously canceled.

STATUS OF AMENDMENTS

All earlier-filed amendments have been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 25 recites a method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in, or available from, a personal computing device, the method comprising: providing the digital data having the title signal [see, e.g., page 4, lines 3-4; see also page 4, lines 9-29]; detecting, at the personal computing device, the title signal in the data, the personal computing device comprises a configured multi-purpose electronic processor, and said act of detecting utilizes the configured multi-purpose electronic processor [see, e.g., page 4, lines 3-4]; comparing the title signal to the player signal [see, e.g., page 9, line 16 – page 10, line 7; see also page 63, lines 5-9]; and performing an action based

upon the comparison [see, e.g., page 9, line 16 – page 11, line 6], in which the player signal expires after a predetermined time such that it is no longer useful for comparison to the title signal [see, e.g., page 19, lines 24-26; see, page 8, lines 20-26; page 9, line 29 – page 10, line 7; page 78, lines 9-16].

Claim 30 recites a method for utilizing a title signal contained in a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a personal computer, the method comprising [See, e.g., U.S. Patent No. 5,862,260 at Col. 27, lines 26-52; Col. 94, lines 28-38; and Col. 41, lines 54 - Col. 42, line 27]: providing the computer readable set of instructions having the title signal [See, e.g., U.S. Patent No. 5,862,260 at Col. 41, lines 54-Col. 42, line 27; Col. 27, lines 25-52; Col. 92, lines 4 – 20, Col. 94, lines 28-47]; utilizing a configured multi-purpose electronic processor, detecting the title signal in the computer readable set of instructions [see, e.g., U.S. Patent No. 5,862,260 at Col. 41, lines 54 - Col. 42, line 27, and Col. 94, lines 28-38; see also Col. 15, lines 45-54]; comparing the title signal to the player signal [see, e.g., U.S. Patent No. 5,862,260 at Col. 41, lines 54-Col. 42, line 27, Col. 27, lines 25-52; and Col. 94, lines 28-38]; and performing an action based upon the comparison in which the action comprises at least informing a computing device user of the comparison or a consequence of the comparison [see, e.g., U.S. Patent No. 5,862,260 at Col. 94, lines 28-38, Col. 27, lines 26-52, and Col. 41, lines 54-Col. 42, line 27]. The 5,862,260 patent is incorporated by reference into the present application. See the subject specification at page 1, line 2 and page 7, lines 20-22.

Claim 43 recites a method for utilizing a title signal contained in digital data to be input into a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a computing device, in which the computing device comprises a multi-purpose electronic processor, the method comprising [See, e.g., U.S. Patent No. 5,862,260 at Col. 27, lines 26-52; Col. 94, lines 28-38; and Col. 41, lines 54 - Col. 42, line 27; see also Col. 15, lines 45-54]: providing the digital data having the title signal [see, e.g., U.S. Patent No. 5,862,260 at Col. 41, lines 54-Col. 42, line 27, Col. 27, lines 25-52, and Col. 92, lines 4 – 20, Col. 94, lines 28-47]; inputting the digital data to the computer readable set of

instructions [See, e.g., U.S. Patent No. 5,862,260 at Col. 92, lines 4 – 20, Col. 94, lines 28-47, col. 94, lines 33-38; and Col. 41, lines 54-Col. 42, line 27]; utilizing the multi-purpose electronic processor configured with the computer readable set of instructions, detecting the title signal in the digital data [see, e.g., U.S. Patent No. 5,862,260 at Col. 41, lines 54-Col. 42, line 27, and Col. 94, lines 28-38; see also Col. 15, lines 45-54]; comparing the title signal to the player signal [see, e.g., U.S. Patent No. 5,862,260 at Col. 41, lines 54-Col. 42, line 27; Col. 27, lines 25-52 and Col. 94, lines 28-38]; and performing an action based upon the comparison, in which the action comprises at least informing a computing device user of the comparison or a consequence of the comparison [see, e.g., U.S. Patent No. 5,862,260 at Col. 41, lines 54-Col. 42, line 27; Col. 27, lines 25-52 and Col. 94, lines 28-38].

Claim 1 recites a method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in a player device, the method comprising [see, e.g., page 4, lines 3-4; see also page 4, lines 9-29]: downloading the digital data having the title signal via an Internet connection, wherein the title signal is carried with digital watermarking encoded in the digital data, in which the digital watermarking is carried in the digital data through alterations to data representing the digital data [see, e.g., page 7, lines 1 and 8-10 and page 4, lines 3-4 and lines 9-14]; transferring the downloaded digital data to the player device [see, e.g., page 5, lines 12-17; page 9, line 16 – page 10, line 7; see also page 63, lines 5-9]; detecting, at the player device, the title signal in the data; comparing the title signal to the player signal, the player device comprises a multi-purpose electronic processor configured as a detector, and said act of detecting utilizes the detector; and comparing the title signal to the player signal; [see, e.g., page 4, lines 3-4, page 9, line 16 – page 10, line 7; see also page 63, lines 5-9]; and performing an action based upon the comparison [see, e.g., page 9, line 16 – page 10, line 7; see also page 63, lines 5-9].

Claim 8 recites the method of claim 7, wherein the consequence is informing the user of the winning of a prize [see, e.g., page 54, lines 24-27; page 74, lines 7-11; page 88, line 5 – 30].

Claim 28 recites the method of claim 27, wherein the consequence is informing the user of the winning of a prize [see, e.g., page 54, lines 24-27; page 74, lines 7-11; page 88, line 5 –

30].

Claim 33 recites the method of claim 32, wherein the consequence is informing the user of the winning of a prize [see, e.g., page 54, lines 24-27; page 74, lines 7-11; page 88, line 5 – 30].

Claim 46 recites the method of claim 45, wherein the consequence is informing the user of the winning of a prize [see, e.g., page 54, lines 24-27; page 74, lines 7-11; page 88, line 5 – 30].

Claim 5 recites the method of claim 4, wherein the digital watermarking contains a copy protection subsignal of a predetermined number of bits, the title signal being a portion of the predetermined number of bits unused by the copy protection subsignal [page 4, lines 15-22; page 15, line 26 – page 16, line 20; page 18, lines 16-28; page 19, line 4 - page 20, line 5; page 28, line 25 – page 30, line 2].

Claim 13 recites the method of claim 1, further comprising encoding the title signal in a time varying manner [see, e.g., page 17, lines 8-15; page 30, lines 19-24; page 38, line 29 – page 39, line 5].

Claim 49 recites a method for utilizing a title signal contained in digital data and a player signal stored in a player device, the player device comprises an a multi-purpose electronic processor, the method comprising: receiving an encrypted title signal at the player device, the encrypted title signal having been encrypted with a private key; utilizing the multi-purpose electronic processor configured as a detector, detecting, at the player device, the title signal in the data; decrypting the encrypted title signal using the player signal as the private key; determining if the result of the act of decrypting results in the title signal; and performing an action based upon the determination [see, e.g., page 9, line 16 – page 10, line 7; see also page 63, lines 5-9; see also page 14, lines 7-11; see also page 50, line 28 – page 51, lines 7].

Claim 52 recites the method of claim 51, wherein the consequence is informing the user of the winning of a prize [see, e.g., page 54, lines 24-27; page 74, lines 7-11; page 88, line 5 – 30].

Of course, additional specification support can be found throughout the application

(including the priority applications) as filed. Thus, citations to specific page and line numbers are by way of example and should not limit specification support or claim scope.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 25-27, 29-32, 34, 36, 38-40, 42, 43, 47, 48 and 56-59 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,619,501 (herein after “the Tamer patent” or simply “Tamer”).
2. Claims 49-51, 54 and 55 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,745,569 (herein after “the Moskowitz patent” or simply “Moskowitz”).
3. Claims 1-24 and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Moskowitz patent in view of the Tamer patent.
4. Claims 28, 33 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamer.
5. Claims 35 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamer in view of Moskowitz.
6. Claim 52 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Moskowitz.

ARGUMENT

Rejections under U.S.C. 102(e) over the Tamer patent

Claim 25 (and dependent claims 26, 36, 37 and 38)

Independent claim 25 recites:

25. A method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in, or available from, a personal computing device, the method comprising:

providing the digital data having the title signal;

detecting, at the personal computing device, the title signal in the data, the personal computing device comprises a configured multi-purpose electronic processor, and said act of detecting utilizes the configured multi-purpose electronic processor;

comparing the title signal to the player signal; and

performing an action based upon the comparison, in which the player signal expires after a predetermined time such that it is no longer useful for comparison to the title signal.

It is well settled that in order for an Office Action to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. See generally, *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Tamer as applied does not anticipate claim 25 because it does not include – either expressly or inherently – at least that the *player signal expires after a predetermined time such that it is no longer useful for comparison to the title signal*.

The September 1, 2009 final Office Action (hereafter referred to as the “Office Action”) cites to Tamer’s Col. 1, line 67 – Col. 2, line 2 for these features. See the Office Action, page 3, paragraph 5, lines 12-15. That Tamer passage reads: *“Only if a match occurs is the processor permitted to process the entitlement data.”* See Tamer, Col. 1, line 67 – Col. 2, line 2.

We see no discussion (either expressly or inherently) in the cited Tamer passage of a player signal expiring after a predetermined time such that it is no longer useful for comparison to the title signal. Thus, the Office Action fails to establish a *prima facie* case of anticipation since Tamer as applied does not have each and every element of claim 25 as arranged therein.

We respectfully request that rejection of claim 25 be reversed.

Claim 27 (and dependent claim 29)

Dependent claim 27 recites:

27. The method of claim 26, wherein the action is to inform a personal computing device user of the match and at least one consequence thereof.

The applied Tamer passage does not anticipate claim 27 because it does not include – either expressly or inherently – each of these features.

Tamer at Col. 3, lines 56-67, are cited for the features of claim 27. See the Office Action, pages 3-4, paragraph 7. This passage is reproduced below for the Board’s convenience.

The microprocessor waits for a programming command from the user via an interface 20, which is shown as a computer keyboard, but which may be a conventional remote control, or receiver front panel switches. The user may request to view a program provided on channel 4 (in the vernacular of analog TV systems). The microprocessor 19 is programmed to scan the program guide list that was loaded in the memory 18 for the respective SCID's of the channel 4 program components, and to lead these SCID's in respective other ones of the programmable registers of the bank of registers 13 which are associated with corresponding component signal processing paths.

This passage does not discuss informing a user of a match, and at least one consequence of the match. Thus, the Office Action fails to establish a *prima facie* case of anticipation since Tamer as applied does not have each and every element of claim 27 as arranged therein

We respectfully request that rejection of claim 27 be reversed.

Claim 30 (and dependent claims 31, 56 and 57)

Independent claim 30 recites:

30. A method for utilizing a title signal contained in a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a personal computing device, the method comprising:

providing the computer readable set of instructions having the title signal;

utilizing a configured multi-purpose electronic processor, detecting the title signal in the computer readable set of instructions;

comparing the title signal to the player signal; and

performing an action based upon the comparison, in which the action comprises at least informing a computing device user of the comparison or a consequence of the comparison.

As discussed above, it is well settled that in order for an Office Action to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. See generally, *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Tamer as applied does not anticipate claim 30 because it does not include – either expressly or inherently – at least performing an action based upon the comparison, in which the action comprises at least informing a computing device user of the comparison or a consequence of the comparison.

The Office Action fails to evaluate all of claim 30's language. For example, in rejecting the above mentioned feature, the Office Action merely analyzes "performing an action based upon the comparison." See the Office Action, page 4, lines 11-12 of paragraph 9. It does not mention what that action comprises, i.e., at least informing a computing device user of the comparison or a consequence of the comparison. Thus, the Office Action is *deficient on its face* because it does not consider each and every feature of the claim.

Moreover, the cited Tamer passage (Col. 1, line 67 – Col. 2, line 2) does not include informing a computing device user of the comparison or a consequence of the comparison.

We respectfully request that rejection of claim 30 be reversed.

Claim 32 (and dependent claims 33, 34 and 35)

Dependent claim 32 recites:

32. The method of claim 31, wherein the action is to inform the personal computing device user of the match and at least one consequence thereof.

Tamer at Col. 3, lines 56-67, are cited for these features. See the Office Action, page 5, paragraph 11. This passage is reproduced below for the Board's convenience.

The microprocessor waits for a programming command from the user via an interface 20, which is shown as a computer keyboard, but which may be a conventional remote control, or receiver front panel switches. The user may request to view a program provided on channel 4 (in the vernacular of analog TV systems). The microprocessor 19 is programmed to scan the program guide list that was loaded in the memory 18 for the respective SCID's of the channel 4 program components, and to lead these SCID's in respective other ones of the programmable registers of the bank of registers 13 which are associated with corresponding component signal processing paths.

This passage does not discuss informing a user of a match, and at least one consequence of the match. Thus, the Office Action fails to establish a *prima facie* case of anticipation since Tamer as applied does not have each and every element of claim 32 as arranged therein

We respectfully request that rejection of claim 32 be reversed.

Claim 39 (and dependent claim 40)

Independent claim 39 recites:

39. A method for utilizing a title signal contained in a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a personal computing device, the method comprising:

providing the computer readable set of instructions having the title signal, in which the computer readable set of instructions represents an application program executable by the personal computing device;

detecting the title signal in the computer readable set of instructions, in which the personal computing device comprises a software operating system for launching the application program, and wherein the act of detecting is performed by the software operating system operating on a multi-purpose electronic processor;

comparing the title signal to the player signal; and

performing an action based upon the comparison.

Tamer as applied does not anticipate claim 39 because it does not include – either expressly or inherently – at least that the *act of detecting* is performed by the *software operating system* operating on a multi-purpose electronic processor.

The Office Action relied on Tamer at Col. 3, lines 37-67 for these features. See the Office Action, pages 5-6, paragraph 15.

We respectfully submit that one of ordinary skill will disagree with the Office Action's analysis.

For example, the cited Tamer passage is not understood to implement an act of detecting a title signal *with a software operating system* operating on a multi-purpose electronic processor. *See Tamer at Col. 3, lines 56-57.* Instead, it appears that a matched filter or decoder 30 provides the detection in Tamer. *See, e.g., Tamer at Col. 5, lines 18-21.*

Claim 39 should be allowed over Tamer since it does not have each and every recited feature as arranged in the claim as applied.

Claim 43 (and dependent claim 47)

Independent claim 43 recites:

43. A method for utilizing a title signal contained in digital data to be input into a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a computing device, in which the computing device comprises a multi-purpose electronic processor, the method comprising:

providing the digital data having the title signal;

inputting the digital data to the computer readable set of instructions;

utilizing the multi-purpose electronic processor configured with the computer readable set of instructions, detecting the title signal in the digital data;

comparing the title signal to the player signal; and

performing an action based upon the comparison of the title signal to the player signal, in which the action comprises at least informing a computing device user of the comparison or a consequence of the comparison.

Tamer as applied does not anticipate claim 43 because it does not include – either expressly or inherently – at least performing an action based upon the comparison of the title signal to the player signal, in which the action comprises at least informing a computing device user of the comparison or a consequence of the comparison.

The Office Action fails to evaluate all of claim 43’s language. For example, in rejecting the above mentioned feature, the Office Action merely analyzes “performing an action based upon the comparison.” See the Office Action, page 7, lines 3-4. It does not mention what that action comprises, i.e., at least informing a computing device user of the comparison or a consequence of the comparison. Thus, the Office Action is *deficient on its face* because it does not consider each and every feature of the claim.

Moreover, the cited Tamer passage (Col. 1, line 67 – Col. 2, line 2; see the Office Action, page 7, lines 3-4) is not understood to include informing a computing device user of the comparison or a consequence of the comparison.

We respectfully request that rejection of claim 43 be reversed.

Claim 48

Dependent claim 48 recites:

48. The method of claim 43, wherein the computer readable set of instructions is a word processing application program and the digital data is a document read thereby.

We are a bit confused by the Office Action's rejection of claim 48. For example, claim 48 recites a word processing application program and a document read thereby.

The Office Action cites Tamer at Col. 2, lines 42-50, for these features. This Tamer passage is reproduced below for the Board's convenience.

For example, V.sub.i, A.sub.i, D.sub.i represent video, audio and data packets and packets designated V.sub.1, A.sub.1, D.sub.1, represent video, audio and data components for program 1, and V.sub.3, A.sub.31, A.sub.32, D.sub.3, represent video, audio 1, audio 2 and data components of program 3. The data packets D.sub.i may contain e.g. control data to initiate certain action within a receiver, or they may include executable code forming an application to be executed by e.g., a microprocessor located within or associated with a receiver.

We do not see any mention of a word processing application or a document read thereby in the cited Tamer passage. Thus, the Office Action fails to establish a *prima facie* case of anticipation for claim 48.

We respectfully request that rejection of claim 48 be reversed.

Rejections under U.S.C. 102(e) over the Moskowitz patent

Claim 49 (and dependent claims 50, 54 and 55)

Independent claim 49 recites:

49. A method for utilizing a title signal contained in digital data and a player signal stored in a player device, the player device comprises an a multi-purpose electronic processor, the method comprising:

receiving an encrypted title signal at the player device, the encrypted title signal having been encrypted with a private key;

utilizing the multi-purpose electronic processor configured as a detector, detecting, at the player device, the title signal in the data;

decrypting the encrypted title signal using the player signal as the private key;

determining if the result of the act of decrypting results in the title signal; and performing an action based upon the determination.

It is well settled that in order for an Office Action to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. See generally, In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677-78 (Fed. Cir. 1988); Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Moskowitz as applied does not anticipate claim 49 because it does not include – either expressly or inherently – decrypting an encrypted title signal using the player signal as the private key.

The Office cites Moskowitz at Col. 6, lines 29-31 for these features. See the Office Action, page 8, lines 4-6. That Moskowitz passage, however, apparently uses a license code (which the Office Action apparently equates to the player signal) to generate a decoding key. (Moskowitz at Col. 6, lines 29-31: “Once it has the license code, it can then generate the proper

decoding key to access the essential code resources.”)

In contrast, claim 49 uses the player signal as the private key.

(We also disagree that Moskowitz at Col. 7, lines 8-21, has every feature of “determining if the result of the act of decrypting results in the title signal.” See the Office Action, page 8, lines 7-8. For example, we are not sure how the cited passage is tied back to the result of the act of decrypting (as applied in the Office Action), and whether it is determined whether the decryption resulting in the title signal.)

We respectfully request that rejection of claim 49 be reversed.

Claim 51

Dependent claim 51 recites:

51. The method of claim 50, wherein the action is to inform a device user of the determination and at least one consequence thereof.

The Office Action cites to Moskowitz’s Col. 3, lines 31-40, for these features. See the Office Action, page 8, paragraph 24. This Moskowitz passage is reproduced below:

An improvement over the art is disclosed in the present invention, in that the software itself is a set of commands, compiled by software engineer, which can be configured in such a manner as to tie underlying functionality to the license or authorization of the copy in possession by the user. Without such verification, the functions sought out by the user in the form of software cease to properly work. Attempts to tamper or "patch" substitute code resources can be made highly difficult by randomizing the location of said resources in memory on an intermittent basis to resist most attacks at disabling the system.

While this passage seems to discuss software ceasing to work properly, it is not understood to inform the device user of a determination and at least one consequence thereof. Thus, the Office Action fails to establish a *prima facie* case of anticipation for claim 51.

We respectfully request that rejection of claim 51 be reversed.

Rejections under U.S.C. 103(a) over Moskowitz in view of Tamer**Claim 1 (and dependent claims 2, 3, 4, 6, 14, 15, 17-22 and 24)**

Independent claim 1 recites:

1. A method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in a player device, the method comprising:

downloading the digital data having the title signal via an Internet connection, wherein the title signal is carried with digital watermarking encoded in the digital data, in which the digital watermarking is carried in the digital data through alterations to data representing the digital data;

transferring the downloaded digital data to the player device;

detecting, at the player device, the title signal in the digital data, the player device comprises a multi-purpose electronic processor configured as a detector, and said act of detecting utilizes the detector;

comparing the title signal to the player signal; and

performing an action based upon the comparison.

Claim 1 recites – in combination with other features – detecting, at a player device, a title signal in the digital data, and comparing the title signal to a player signal stored in the player device.

There are significant differences between the applied prior art documents – Moskowitz and Tamer – themselves. Indeed, the Moskowitz patent and the Tamer patent seem incompatible; that is, there does not appear to be sufficient “interrelated teachings of multiple patents” to support the proposed combination. Lacking sufficient interrelated teachings cuts against a finding of obviousness. See KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007) (“Often, it will be necessary for a court to look to interrelated teachings of multiple patents... all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.”).

For example, Moskowitz is not understood to make any comparison between signals. Instead, Moskowitz seems to determine whether a watermark has been erased. See Moskowitz, Col. 7, 17-21. In contrast, Tamer uses a filter 30 to compare codes with incoming signals.

Thus, we respectfully submit that there is not a sufficient reason to combine the documents in the manner suggested.

We respectfully request that rejection of claim 1 be reversed.

Claim 5

Dependent claim 5 recites:

5. The method of claim 4, wherein the digital watermarking contains a copy protection subsignal of a predetermined number of bits, the title signal being a portion of the predetermined number of bits unused by the copy protection subsignal.

The cited Moskowitz passages, Col. 6, lines 32-37, and Col. 7, lines 17-21, do not discuss a subsignal of a predetermined number of bits, or a title signal being a portion of used bits.

And, while the cited Tamer passage (Col. 5, line 15-21) discusses a 128 bit header arranged in 4 groups of 32 bits, it is not understood to render obvious a title signal being a portion of the predetermined number of bits unused by the copy protection subsignal.

We respectfully request that rejection of claim 5 be reversed.

Claim 7 (and dependent claims 9-11)

Dependent claim 7 recites:

7. The method of claim 6, wherein the action is to inform the device user of the match and at least one consequence thereof.

The Office Action states that a user would reasonably know the outcome of Tamer's comparison at Col. 1, lines 61-67. Even if this were the case (which we do not concede), it still does not address the claim language of informing the device user of the match and at least one

consequence thereof. Thus, the Office Action is deficient on its face. We respectfully request that rejection of claim 7 be reversed.

Claim 8

Dependent claim 8 recites:

8. The method of claim 7, wherein the consequence is informing the user of the winning of a prize.

The Office Action correctly notes that Moskowitz as modified by Tamer does not disclose a consequence of informing a user of winning a prize. See the Office Action, page 12, paragraph 34.

Tamer relates to a conditional access filter to determine whether to descramble portions of transmitted signals. See Tamer's Abstract. Moskowitz relates to a stega-ciper protection of computer codes (e.g., protecting computer doe copyrights). See Moskowitz's Abstract. While these documents may discuss protection techniques they do not seem to lend themselves to informing users of winning prizes.

Thus, we respectfully submit that one of ordinary skill would not likely find it obvious to inform a user of winning a prize after reviewing Moskowitz and Tamer.

We respectfully request that rejection of claim 8 be reversed.

Claim 12

Dependent claim 12 recites:

12. The method of claim 3, wherein the player signal is indicative of a device number.

We respectfully submit that the Office Action overstates the significance of Tamer with respect to claim 12. See the Office Action, page 13, paragraph 38. There, the Office Action points to Tamer at Col. 1, lines 64-65, as rendering obvious a playing signal indicative of a device number. Instead, this passage merely discusses a subscriber specific conditional access

codeword. There does not appear to be an apparent nexus between the subscriber's codeword and a device number.

We respectfully request that rejection of claim 12 be reversed.

Claim 13

Dependent claim 13 recites:

13. The method of claim 1, in which the title signal is encoded with the digital watermarking in a time varying manner.

Recall from claim 1 that the title signal is carried with digital watermarking encoded in digital data. Claim 13 requires that the title signal is encoded (in the digital data) with the digital watermark in a time varying manner.

The Office Action cites Moskowitz's Col. 8, lines 3-10, for these features. See the Office Action, page 13, paragraph 39. The cited Moskowitz passage is reproduced below.

During execution time, this special code resource, called a "memory scheduler," can be called periodically, or at random or pseudo random intervals, at which time it intentionally shuffles the other code resources randomly in memory, so that someone trying to analyze snapshots of memory at various intervals cannot be sure if they are looking at the same code or organization from one "break" to the next.

This passage seems to deal with shuffling code resources in computer memory. This does not discuss a title signal (encoded in digital data) with digital watermarking in a time varying manner.

We respectfully request that rejection of claim 13 be reversed.

Claim 16

Dependent claim 16 recites:

16. The method of claim 6, wherein imperfect or approximate matching between the title signal and player signal is permitted in order to perform the action.

We respectfully submit that the Office Action overstates the significance of Moskowitz relative to claim 16. See the Office Action, page 14, paragraph 42. There, the Office Action suggests that Moskowitz's Col. 4, lines 29-35, somehow shows imperfect or approximate matching because "not all SCIDs have to be matched." We do not see mention of not all SCIDs having to be matched in the cited passage, reproduced below. In fact, the so-called "resources" (below) are not understood to be involved in any matching.

Within an application there are also data objects, which consist of some data to be operated on by the executable code. These data objects are not executable. That is, they do not consist of executable instructions. The data objects can be referred to in certain systems as "resources." When a user purchases or acquires a computer program, she seeks a computer program that "functions" in a desired manner.

We respectfully request that rejection of claim 16 be reversed.

Claim 23

Dependent claim 23 recites:

23. The method of claim 21, wherein the acts of detecting, comparing and performing are performed after the downloaded digital data is partially stored such that the title signal is available for use in the method before the act of storing is completed.

The Office Action overstates the significance of Tamer relative to claim 23. See the Office Action, page 15, paragraph 49. There, the Office Action suggests that Tamer's Col. 4,

lines 28-35, discloses data partially stored prior to comparison. We respectfully disagree. Indeed, it appears that matching is evaluated after SCIDS have been stored in programmable registers.

In the steady state, after the program SCID's have been stored in the programmable registers 13, the SCID's of received signal packets are compared with all of the SCID's in the programmable SCID registers. If a match is made with either a stored audio, video or data SCID, the corresponding packet payload will be stored in the audio, video or data memory area or block respectively.

We respectfully request that rejection of claim 23 be reversed.

Rejections under U.S.C. 103(a) over Tamer

Claim 28

Dependent claim 28 recites:

28. The method of claim 27, wherein the consequence is informing the user of the winning of a prize.

The Office Action correctly notes that Tamer does not disclose a consequence of informing a user of winning a prize. See the Office Action, page 16, paragraph 52.

Tamer relates to a conditional access filter to determine whether to descramble portions of transmitted signals. See Tamer's Abstract. While this may relate to protection techniques, we do not understand how this would lend itself to informing a user of winning a prize. And, “outputting video, audio, or pertinent information” (as alluded to in the Office Action) is not tied to winning a prize.

Thus, we respectfully submit that one of ordinary skill would not likely find it obvious to inform a user about winning a prize after reviewing Tamer.

We respectfully request that rejection of claim 28 be reversed.

Claim 33

Dependent claim 33 recites:

33. The method of claim 32, wherein the consequence is informing the user of the winning of a prize.

The rejection of claim 33 should be reversed for reasons similar to those discussed with respect to claim 28.

Claim 46

Dependent claim 46 recites:

46. The method of claim 45, wherein the consequence is informing the user of the winning of a prize.

The rejection of claim 46 should be reversed for reasons similar to those discussed with respect to claim 28.

Rejections under U.S.C. 103(a) over Tamer in view of MoskowitzClaim 37

Dependent claim 37 recites:

37. The method of claim 25, wherein the act of detecting comprises computing the player signal from the information available from the personal computing device.

The Office Action relies on Moskowitz at Col. 7, lines 1-21, for these features. See the Office Action, page 18, paragraph 57. We respectfully disagree with this analysis. For example, the Office Action alludes that this passage discusses computing a player signal through decryption. We do not see this discussion in the cited passage (reproduced below).

A preferred embodiment would be implemented in an embedded system, with a minimal operating system and memory. No media playing "applets," or smaller sized applications as proposed in new operating environments envisioned by Sun Microsystems and the advent of Sun's Java operating system, would be permanently stored in the system, only the bare necessities to operate the device, download information, decode watermarks and execute the applets contained in them. When an applet is finished executing, it is erased from memory. Such a system would guarantee that content which did not contain readable watermarks could not be used. This is a powerful control mechanism for ensuring that content to be distributed through such a system contains valid watermarks. Thus, in such networks as the Internet or set-top box controlled cable systems, distribution and exchange of content would be made more secure from unauthorized copying to the benefit of copyright holders and other related parties. The system would be enabled to invalidate, by default, any content which has had its watermark(s) erased, since the watermark conveys, in addition to copyright information, the means to fully access, play, record or otherwise manipulate, the content.

We respectfully submit that the Office Action overstates the significance of Moskowitz at the cited Col. 7 passage. We respectfully request that the rejection of claim 37 be reversed.

Rejections under U.S.C. 103(a) over Moskowitz

Claim 52

Dependent claim 52 recites:

52. *The method of claim 51, wherein the consequence is informing the user of the winning of a prize.*

The Office Action correctly notes that Moskowitz does not disclose a consequence of informing a user of winning a prize. See the Office Action, page 18, paragraph 59.

Moskowitz relates protecting computer code copyrights by encoding a code into a data resource. See Moskowitz's Abstract. While this may relate to copyright techniques, we do not understand how this would lend itself to informing user of winning a prize. And "outputting video, audio, or pertinent information" (as alluded to in the Office Action) is not tied to winning a prize.

Thus, we respectfully submit that one of ordinary skill would not likely find it obvious to inform a user about winning a prize after reviewing Moskowitz.

We respectfully request that rejection of claim 52 be reversed.

CONCLUSION AND REQUEST FOR REVERSAL

Appellants respectfully request the Board to reverse the final rejection of the pending claims.

Respectfully submitted,

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CLAIMS APPENDIX

1. (previously presented): A method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in a player device, the method comprising:

downloading the digital data having the title signal via an Internet connection, wherein the title signal is carried with digital watermarking encoded in the digital data, in which the digital watermarking is carried in the digital data through alterations to data representing the digital data;

transferring the downloaded digital data to the player device;

detecting, at the player device, the title signal in the digital data, the player device comprises a multi-purpose electronic processor configured as a detector, and said act of detecting utilizes the detector;

comparing the title signal to the player signal; and

performing an action based upon the comparison.

2. (original): The method of claim 1, wherein the digital data is streaming audio or video data.

3. (original): The method of claim 1, wherein the player signal is indicative of an attribute of the device, device user, data, or data owner.

4. (previously presented): The method of claim 1 further comprising:
decoding the digital watermarking to obtain the title signal.

5. (previously presented): The method of claim 4, wherein the digital watermarking contains a copy protection subsignal of a predetermined number of bits, the title signal being a portion of the predetermined number of bits unused by the copy protection subsignal.

6. (original): The method of claim 1, wherein the action is performed if the title signal matches the player signal.

7. (original): The method of claim 6, wherein the action is to inform the device user of the match and at least one consequence thereof.

8. (original): The method of claim 7, wherein the consequence is informing the user of the winning of a prize.

9. (original): The method of claim 7, wherein the digital data is digital video data.

10. (previously presented): The method of claim 7, wherein the digital data comprises digital audio data.

11. (original): The method of claim 7, wherein the action is to inform the device user of the match and of the player signal.

12. (original): The method of claim 3, wherein the player signal is indicative of a device number.

13. (previously presented): The method of claim 1, in which the title signal is encoded with the digital watermarking in a time varying manner.

14. (previously presented): The method of claim 3, further comprising inputting the player signal to the player device prior to the act of comparing.

15. (original): The method of claim 6, wherein perfect matching between the title signal and player signal is necessary in order to perform the action.

16. (original): The method of claim 6, wherein imperfect or approximate matching between the title signal and player signal is permitted in order to perform the action.

17. (original): The method of claim 6, wherein the title signal and player signal contain at least two fields, each field comprising a group of bits, wherein matching of fields between the title signal and player signal is permitted in order to perform the action.

18. (original): The method of claim 1, wherein at least one title signal which when compared to the player signal evokes the performance of the action.

19. (original): The method of claim 1, wherein at least one title signal which when compared to the player signal evokes the performance of the action, is chosen to match at least one targeted demographic group.

20. (original): The method of claim 1, wherein the action is performed if the title signal matches the player signal and the action is to inform the device user of the match.

21. (previously provided): The method of claim 1, wherein the player device is a personal computer and the act of transferring comprises storing the downloaded data to a recordable medium readable by the player device.

22. (previously provided): The method of claim 21, wherein the acts of detecting, comparing and performing are performed after the act of storing is completed.

23. (previously provided): The method of claim 21, wherein the acts of detecting, comparing and performing are performed after the downloaded digital data is partially stored such that the title signal is available for use in the method before the act of storing is completed.

24. (previously provided): The method of claim 1, wherein the player device is a personal computer and at least the act of detecting is performed in real time as the digital data is downloaded.

25. (previously presented): A method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in, or available from, a personal computing device, the method comprising:

providing the digital data having the title signal;

detecting, at the personal computing device, the title signal in the data, the personal computing device comprises a configured multi-purpose electronic processor, and said act of detecting utilizes the configured multi-purpose electronic processor;

comparing the title signal to the player signal; and

performing an action based upon the comparison, in which the player signal expires after a predetermined time such that it is no longer useful for comparison to the title signal.

26. (original): The method of claim 25, wherein the action is performed if the title signal matches the player signal.

27. (previously presented): The method of claim 26, wherein the action is to inform a personal computing device user of the match and at least one consequence thereof.

28. (original): The method of claim 27, wherein the consequence is informing the user of the winning of a prize.

29. (original): The method of claim 27, wherein the action is to inform the personal computer user of the match and of the player signal.

30. (previously presented): A method for utilizing a title signal contained in a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a personal computing device, the method comprising:

providing the computer readable set of instructions having the title signal;

utilizing a configured multi-purpose electronic processor, detecting the title signal in the computer readable set of instructions;

comparing the title signal to the player signal; and

performing an action based upon the comparison, in which the action comprises at least informing a computing device user of the comparison or a consequence of the comparison.

31. (original): The method of claim 30, wherein the action is performed if the title signal matches the player signal.

32. (previously presented): The method of claim 31, wherein the action is to inform the personal computing device user of the match and at least one consequence thereof.

33. (original): The method of claim 32, wherein the consequence is informing the user of the winning of a prize.

34. (previously presented): The method of claim 32, wherein the action is to inform the personal computing device user of the match and of the player signal.

35. (previously presented): The method of claim 34, wherein the computer readable set of instructions having the title signal contained therein is provided to the personal computing device by downloading via an Internet connection.

36. (original): The method of claim 25, wherein the player signal is embedded within the computer readable set of instructions.

37. (previously presented): The method of claim 25, wherein the act of detecting comprises computing the player signal from the information available from the personal computing device.

38. (previously provided): The method of claim 25, wherein the act of comparing is performed by a subset of instructions contained within the computer readable set of instructions.

39. (previously presented): A method for utilizing a title signal contained in a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a personal computing device, the method comprising:

providing the computer readable set of instructions having the title signal, in which the computer readable set of instructions represents an application program executable by the personal computing device;

detecting the title signal in the computer readable set of instructions, in which the personal computing device comprises a software operating system for launching the application program, and wherein the act of detecting is performed by the software operating system operating on a multi-purpose electronic processor;

comparing the title signal to the player signal; and

performing an action based upon the comparison.

40. (previously provided): The method of claim 39, wherein the operating system also performs the acts of comparing and performing.

41. canceled.

42. (previously presented): The method of claim 25 further comprising updating the player signal for comparison to the title signal.

43. (previously presented): A method for utilizing a title signal contained in digital data to be input into a computer readable set of instructions through a comparison of the title signal to a player signal stored in, or available from, a computing device, in which the computing device comprises a multi-purpose electronic processor, the method comprising:

providing the digital data having the title signal;
inputting the digital data to the computer readable set of instructions;
utilizing the multi-purpose electronic processor configured with the computer readable set of instructions, detecting the title signal in the digital data;
comparing the title signal to the player signal; and
performing an action based upon the comparison of the title signal to the player signal, in which the action comprises at least informing a computing device user of the comparison or a consequence of the comparison.

44. canceled.

45. canceled.

46. (original): The method of claim 45, wherein the consequence is informing the user of the winning of a prize.

47. (previously presented): The method of claim 43, wherein the action further comprises informing the computing device user of the player signal.

48. (original): The method of claim 43, wherein the computer readable set of instructions is a word processing application program and the digital data is a document read thereby.

49. (previously presented): A method for utilizing a title signal contained in digital data and a player signal stored in a player device, the player device comprises a multi-purpose electronic processor, the method comprising:

receiving an encrypted title signal at the player device, the encrypted title signal having been encrypted with a private key;

utilizing the multi-purpose electronic processor configured as a detector, detecting, at the player device, the title signal in the data;

decrypting the encrypted title signal using the player signal as the private key;

determining if the result of the act of decrypting results in the title signal; and

performing an action based upon the determination.

50. (original): The method of claim 49, wherein the action is performed if the result of the decryption results in the title signal.

51. (previously presented): The method of claim 50, wherein the action is to inform a device user of the determination and at least one consequence thereof.

52. (original): The method of claim 51, wherein the consequence is informing the user of the winning of a prize.

53. (previously presented): A computer readable media comprising instructions stored thereon to cause a multi-purpose computer processor to perform the acts of detecting, comparing and performing as recited in claim 1.

54. (previously presented): A programmed player device storing instructions in memory, said instructions are executable by said programmed player device to perform the acts of claim 49.

55. (previously presented): A computer readable media comprising instructions stored thereon to cause a multi-purpose electronic processor to perform the acts of claim 49.

56. (previously presented): A programmed personal computing device storing instructions in memory, said instructions are executable by said programmed personal computing device to perform the acts of claim 30.

57. (previously presented): A computer readable media comprising instructions stored thereon to cause a multi-purpose electronic processor to perform the acts of claim 30.

58. (previously presented): A programmed personal computing device storing instructions in memory, said instructions are executable by said programmed personal computing device to perform the acts of claim 25.

59. (previously presented): A computer readable media comprising instructions stored thereon to cause a multi-purpose electronic processor to perform the acts of claim 25.

EVIDENCE APPENDIX

(No Evidence)

RELATED PROCEEDINGS APPENDIX